

REMARKS

Applicant has carefully reviewed the Application in light of the Advisory Action mailed February 18, 2005. At the time of the Advisory Action, Claims 1-55 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-3, 5, 11-13, 15, 21-23, 31-33, 39-43, and 46-48 under 35 U.S.C. §103(a) as being anticipated by U.S. Patent No. 6,711,141 issued to Rinne (hereinafter "*Rinne*") in view of U.S. Patent No. 6,587,457 issued to Mikkonen (hereinafter "*Mikkonen*") and further in view of U.S. Publication No. 2002/0067704 A1 issued to Ton (hereinafter "*Ton*"). The Examiner rejects Claims 1, 11, 21, 31, 41, 46, and 51 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen* and *Ton*, as applied to Claims 1, 11, 21, 31, 41, 46, and 51, and further in view of International Publication No. WO 98/44639 issued to Mustajarvi (hereinafter "*Mustajarvi*"). The Examiner rejects Claims 6-7, 16-17, 26-27, and 36-37 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen* and *Ton*, as applied to Claims 1, 11, 21, and 31 and further in view of U.S. Patent No. 6,680,943 issued to Gibson (hereinafter "*Gibson*"). The Examiner rejects Claims 8-9, 18-19, 28-29, and 38 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen*, *Ton*, and *Gibson* as applied to Claims 6, 16, 26, and 36 and further in view of *Mustajarvi*. The Examiner rejects Claims 10, 20, and 30 under 35 U.S.C. §103(a) as being unpatentable over *Rinne* in view of *Mikkonen*, *Ton*, and *Gibson* as applied to Claims 6, 16, 26, and 36 and further in view of well-establishing teaching in art. These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

¹ See M.P.E.P. §2142-43.

It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. For example, Independent Claim 1 recites: correlating the label information to the data session, wherein the mobile unit is operable to: allocate a session specific label in response to session activity associated with an end user of the mobile unit and ***communicate a new label stack to the serving node*** such that the serving node can perform routing at a layer two level.

In contrast to the teachings of Independent Claim 1, nothing in *Rinne*, *Mikkonen*, *Gibson*, or *Ton* offer any architecture that offers an ability to ***communicate a new label stack to the serving node*** such that the serving node can perform routing at a layer two level. There is simply no “new label stack” disclosed in any of the portions of *Rinne* cited by the Examiner. In the Office Action, the Examiner mistakenly relies on an erroneous portion of *Rinne* that merely provides: “Another local 16 bit code point space is XXXX11, so it is in principle possible to separate 16 different QoS profiles by a code point. Code points and the corresponding profiles are also maintained in the packet classifier PAC, so the PAC is, according to the IP source address and said DSCP field in the IP header, able to sort the packets to be sent in uplink direction in an essentially unique manner to be sent conforming to the desired QoS profile.” (See *Rinne*: Column 6, lines 44-52.) Obviously, this is not akin to *communicating a new label stack to the serving node* such that the serving node can perform routing at a layer two level, as there is no “new label stack” even presented: much less one that would enable routing at a layer two level.

This absence of support, in the cited references, is presumably because these references lack these missing items. Evaluating the references more closely confirms that these elements are simply not found therein. Note that if none of these references provides a new label stack that is communicated to the serving node, then the result is that none of the references can offer the layer-two routing feature of the present invention. The absence of this layer-two routing feature was also conceded by the Examiner; this is presumably why *Mikkonen* has made an appearance in the Office Action. However, *Mikkonen* discloses nothing relevant to the “new label stack,” as identified herein. Thus, any layer-two routing taught by *Mikkonen* would simply be in a completely different context. For at least these reasons, Independent Claim 1 is patentably distinct from *Rinne* and *Mikkonen*.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Rinne* reference or of the proposed *Rinne-Mikkonen*, *Rinne-Gibson*, *Rinne-Mustajarvi*, or *Rinne-Ton* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Rinne*, *Mikkonen*, *Gibson*, *Mustajarvi* or in *Ton*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.² Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.³

Nothing in *Rinne*, *Mikkonen*, *Gibson*, *Mustajarvi* or in *Ton* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁴ This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁵ guidelines and governing Federal Circuit case law.⁶ The M.P.E.P. consistently

² M.P.E.P. §2143.01 (emphasis in original).

³ In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁴ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

⁵ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

confirms that this approach is improper and, thus, it should not be used here.⁷ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”⁸ Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”⁹

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Independent Claims 11, 21, 31, 41, 46, and 51 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁷ See M.P.E.P. §2145.

⁸ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

⁹ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

ATTORNEY DOCKET NO.
062891.0511

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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Date: February 28, 2005

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